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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,038	03/24/2000	Scott J. Wolf	7883.0004-02	2278

22852 7590 11/05/2003

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WASHINGTON, DC 20005

EXAMINER
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BIANCO, PATRICIA

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 11/05/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/534,038

Applicant(s)

WOLF ET AL.

Examiner

Patricia M Bianco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 15-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12/13/16.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

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## **DETAILED ACTION**

### ***Response to Amendment***

Multiple preliminary amendments were filed for this application. The amendment filed 3/4/03 cancelled claims 1-4; amended claim 15; and added claims 16-47. The amendment filed 6/20/03 added claims 48-72. The amendment filed 7/16/03 cancelled claims 48-72. At this time, claims 15-47 are pending and have been examined on the merits.

### ***Election/Restrictions***

Applicant's election without traverse of Group IX, claims 15-47, in Paper No. 11 is acknowledged.

No claims are withdrawn since all the non-elected claims have been cancelled in one of the preliminary amendments noted above.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 15-46 are rejected under 35 U.S.C. 102(e) as being anticipated by Phelps et al. (6,290,728). Phelps discloses a method for inserting an implant (which may be a stent, shunt or the like) into a channel or passageway formed between a coronary vessel and the heart wall or myocardium. If a stent is used as the implant, it may be

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deployed using a balloon or may be self expanding. The implant may be formed of a biodegradable material or a bio-absorbable material. The implant may also release drugs, genes, angiogenesis or growth factors, or other pharmaceutical compounds into the muscle. The procedure or method comprises the steps of inserting a delivery device into the coronary vessel. The delivery device comprises a conduit, such as a catheter, a trocar or another suitable device for practicing minimally invasive vascular or surgical techniques. The delivery conduit may have a lumen to fit the implant within or pass the implant through or may have the implant mounted thereon. The preferred conduit is a trocar-like device that penetrates the tissue of the patient to form a hole or channel in the myocardium.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phelps et al. ('728). **REF X** discloses the invention substantially as claimed, see rejection supra, however, fails to disclose specifically that the delivery device comprises a thoroscope. Phelps does teach that the delivery device comprises a conduit, such as a catheter, a trocar or another suitable device for practicing minimally invasive vascular or surgical techniques. Since it is well known in the art to use a thoroscope to perform

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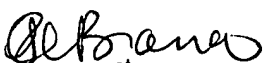
minimally invasive vascular or surgical procedures, at the time of the invention, it would have been an obvious design choice to modify the method of inserting an implant to use a thoroscope to better visualize the surgical field while working.

### ***Conclusion***

Any inquiry concerning the rejections contained within this communication or earlier communications should be directed to examiner Tricia Bianco whose telephone number is (703) 305-1482. The examiner can normally be reached on Monday through Fridays, alternating Fridays off, from 9:00 AM until 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The official fax numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular and After Final communications.

Tricia Bianco  
Patent Examiner  
Art Unit 3762

pmb   
November 1<sup>st</sup>, 2003